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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,117	01/30/2002	Mitchell B. Oliver	020229	9924
23596	7590	10/08/2008		
QUALCOMM INCORPORATED			EXAMINER	
5775 MOREHOUSE DR.			NGUYEN, NGA B	
SAN DIEGO, CA 92121				
		ART UNIT	PAPER NUMBER	
		3692		
		NOTIFICATION DATE	DELIVERY MODE	
		10/08/2008	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/062,117

Applicant(s)

OLIVER ET AL.

Examiner

Nga B. Nguyen

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6 and 8-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 20, 2008 has been entered.
2. Claims **1-3, 5, 6, and 8-21** are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-3, 5, 6, and 8-21 have been considered but are not persuasive.

In response to applicant's arguments against the reference individually (see page 4, first paragraph, arguments against Del Sesto, US 6,985,882 only), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references (Del Sesto, US 6,985,881 and Coyle, US 6,269,157). See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner submits that the Supreme Court in *KSR* described the rationales to support rejections under 35 U.S.C. 103: Combining prior art elements according to known methods to yield predictable results; or Simple substitution of one

known element for another to obtain predictable results. In this case, Coyle discloses buyers can be resellers to resell the service to their customers (column 15, lines 13-40, the end users or resellers purchase telecommunications service at the lower of the bid price in the auction or a negotiated price from the telecommunications service provider), therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Del Sesto's to incorporate the feature taught by Coyle above, which can obtain the predictable result that the media buyers can be media resellers to resell the advertising time or advertising space to their clients. Also, see Del Sesto, column 4, lines 50-60, buyer is an advertising agency who can buy advertising time or advertising space on behalf of clients, thus it is obvious and predictable that the advertising agency can resell advertising time or advertising space to their clients for commission.

In response to applicant's argument that Del Sesto, US 6,985,881 and Coyle, US 6,269,157 are non-analogous art, it has been held that a second prior art reference must either be in the field of the first prior art reference or, if not, then be reasonably pertinent to the particular problem with which the first prior art was concerned, in order to be relied upon as a basis for rejection of the claimed invention. In this case, Del Sesto discloses media buyers make bids to media sellers for selected advertising units, Coyle discloses resellers (as buyers) make bids to carriers for telecommunication services. Therefore, Del Sesto's and Coyle's references are in the same field (auction prior arts).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-3, 8-10, 16, 18, 20 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1-3, 8-10, 16, 18, 20 and 21 fail to meet the above requirements because they are not tied to another statutory class of invention. Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a

statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5, 6, and 8-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Del Sesto, U.S. Patent No. 6,985,882, in view of Coyle, U.S. Patent No. 6,269,157.

Regarding to claim 1, Del Sesto discloses a method for correlating information associated with one or more products between multiple entities, comprising:

receiving a first data associated with each of the one or more products from a first delivery entity (column 4, lines 20-40 and column 5, lines 35-43, the server 101 includes a database 200 stored data records pertaining to media seller, e.g. Program Listing 320 contains a schedule of shows and showtimes for the seller; Note that media seller is equivalent to delivery entity in the claimed invention);

presenting to the multiple provider entities, the first data associated with each of one or more products (figures 4D-4F and column 6, line 58-column 7, line 22,

presenting to the media buyers a list of avail sets by station in the selected market, the day and time, show category, daypart, demographic information, number of avails advertising slots for that show; Note that media buyer is equivalent to provider entity in the claimed invention);

receiving a first modification to the first data by a first of the multiple provider entities (figure 4G and column 7, lines 23-30, the media buyer will see the seller's start price for the avail set by station, and will enter the counter offer for the avail set);

presenting the first modification to the first data to the first delivery entity (figure 5G and column 9, lines 4-10, the incoming bids sent to the media seller);

receiving an acceptance of the first modification from the first delivery entity (column 9, lines 7-10, the media seller views the contract for the bid, reject the bid, or accept the bid); and

associating the first modification with the first of multiple provider entities (figure 5G, associating each bid with the media buyer's name);

offering at least one of the one or more products to clients of the first of the multiple provider entities according to the first modification of the first data (column 1, lines 10-50 and column 2, lines 25-40, the media buyer (the advertiser) buys advertising spaces from the media seller (the media agency) in order to deliver advertising contents to the viewers).

Del Sesto does not disclose wherein the clients of the first multiple provider entities are capable of purchasing the at least one of the one or more products. However, Coyle discloses wherein the clients of the first multiple provider entities are

capable of purchasing the at least one of the one or more products (column 15, lines 13-40, the end users and resellers purchase telecommunications service at the lower of the bid price in the auction or a negotiated price from the telecommunications service provider). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Del Sesto's to incorporate the feature taught by Coyle above, for the purpose of providing the clients of the first multiple provider entities are capable of purchasing the at least one of the one or more products.

Regarding to claim 2, Del Sesto further discloses storing the one or more products and the first modification in a central repository (column 4, lines 32-40, database 200 stores media schedule records 204 and buyer bid records 206).

Regarding to claim 3, Del Sesto further discloses receiving a second modification to the first data from a second of the multiple provider entities; receiving an acceptance of the second modification from the first delivery entity; and associating the second modification with the second of the multiple provider entities; offering at least one of the one or more products to clients of the second of the multiple provider entities according to the second modification of the first data (figure 5G and column 9, lines 4-10, the incoming bids sent to the media seller, thus the multiple media buyers included the second media buyer submit bids to the media seller). Del Sesto does not disclose wherein the clients of the second multiple provider entities are capable of purchasing the at least one of the one or more products. However, Coyle discloses wherein the clients of the first multiple provider entities are capable of purchasing the at least one of the one or more products (column 15, lines 13-40, the end users and resellers purchase

telecommunications service at the lower of the bid price in the auction or a negotiated price from the telecommunications service provider). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Del Sesto's to incorporate the feature taught by Coyle above, for the purpose of providing the clients of the second multiple provider entities are capable of purchasing the at least one of the one or more products.

Claims 5 and 6 are written in means that parallel the limitations found in claims 1 and 3 above, therefore, are rejected by the same rationale.

Claims 8-10 contain similar limitations found in claims 1-3 above, therefore, are rejected by the same rationale (Note that in this case, the carrier is equivalent to the media buyer, the developer is equivalent to the media seller).

Claims 11-13 are written in means that parallel the limitations found in claims 8-10, therefore, are rejected by the same rationale.

Claims 14 and 15 are written computer-readable medium that parallel the limitations found in claims 8 and 9 above, therefore, are rejected by the same rationale.

Regarding to claim 16, Del Sesto discloses a method of negotiating metadata associated with an application, comprising:

receiving metadata associated with multiple applications (column 4, lines 20-40 and column 5, lines 35-43, the server 101 includes a database 200 stored data records pertaining to media seller, e.g. Program Listing 320 contains a schedule of shows and showtimes for the seller);

presenting the metadata to multiple carriers (figures 4D-4F and column 6, line 58-column 7, line 22, presenting to the media buyers a list of avail sets by station in the selected market, the day and time, show category, daypart, demographic information, number of avails advertising slots for that show; Note that the media buyer is equivalent to the carrier, the media seller is equivalent to the developer in this claim);

providing an automated negotiation forum for the carriers and developers (column 2, lines 45-55);

receiving into the negotiation forum, modifications to the metadata from carriers (figure 4G and column 7, lines 23-30, the media buyer will see the seller's start price for the avail set by station, and will enter the counter offer for the avail set);

modifications to the metadata from developers, acceptance requests from carriers and acceptance requests from developers (column 9, lines 7-10, the media seller views the contract for the bid, reject the bid, or accept the bid);

associating metadata associated with one of the multiple applications with one or more of the multiple carriers (figure 5G, associating each bid with the media buyer's name);

offering the one of the multiple applications to clients of the carrier according to the associated metadata (column 1, lines 10-50 and column 2, lines 25-40, the media buyer (the advertiser) buys advertising spaces from the media seller (the media agency) in order to deliver advertising contents to the viewers).

Del Sesto does not disclose wherein the clients of the first multiple provider entities are capable of purchasing the at least one of the one or more products.

However, Coyle discloses wherein the clients of the first multiple provider entities are capable of purchasing the at least one of the one or more products (column 15, lines 13-40, the end users and resellers purchase telecommunications service at the lower of the bid price in the auction or a negotiated price from the telecommunications service provider). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Del Sesto's to incorporate the feature taught by Coyle above, for the purpose of providing the clients of the first multiple provider entities are capable of purchasing the at least one of the one or more products.

Moreover, Del Sesto does not disclose the application for execution on a wireless device. However, executing an application on a wireless device is well known in the art. For example, portable devices (e.g. laptops, PDAs, mobile phones, etc.) can access the Internet for conducting transactions via the wireless network. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Del Sesto's to incorporate the well-known feature above, for the purpose of providing more convenient for customer to conduct transactions over the Internet using a wireless device.

Claim 17 is written in means that parallel the limitations found in claim 16 above, therefore, is rejected by the same rationale.

Regarding to claim 18, Del Sesto discloses a method for providing a negotiation forum, comprising:

providing electronic access to an automated system to multiple provider entities and multiple delivery entities (column 2, lines 20-55, providing media buyers and media

sellers access to central server over the network; Note that media buyer is equivalent to delivery entity, media seller is equivalent to provider entity in this claims);

presenting to the multiple delivery entities metadata associated with products associated with the multiple provider entities (figures 4D-4F and column 6, line 58-column 7, line 22, presenting to the media buyers a list of avail sets by station in the selected market, the day and time, show category, daypart, demographic information, number of avails advertising slots for that show);

receiving modification terms associated with the metadata associated with the products associated with the multiple provider entities (figure 4G and column 7, lines 23-30, the media buyer will see the seller's start price for the avail set by station, and will enter the counter offer for the avail set);

receiving acceptance of modifications to the metadata (column 9, lines 7-10, the media seller views the contract for the bid, reject the bid, or accept the bid);

associating the modification of the metadata with multiple delivery entities (figure 5G, associating each bid with the media buyer's name);

offering at least one of the one or more products associated with one of the multiple provider entities to clients of one of the multiple delivery entities according to the associated modified metadata (column 1, lines 10-50 and column 2, lines 25-40, the media buyer (the advertiser) buys advertising spaces from the media seller (the media agency) in order to deliver advertising contents to the viewers).

Del Sesto does not disclose wherein the clients of the first multiple provider entities are capable of purchasing the at least one of the one or more products.

However, Coyle discloses wherein the clients of the first multiple provider entities are capable of purchasing the at least one of the one or more products (column 15, lines 13-40, the end users and resellers purchase telecommunications service at the lower of the bid price in the auction or a negotiated price from the telecommunications service provider). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Del Sesto's to incorporate the feature taught by Coyle above, for the purpose of providing the clients of the first multiple provider entities are capable of purchasing the at least one of the one or more products.

Claim 19 is written in computer-readable medium that parallel the limitations found in claim 18 above, therefore, is rejected by the same rationale.

Regarding to claims 20-21, Del Sesto does not disclose wherein the offering step includes conveying the first modification to the first data to the clients and wherein the first modification of the first data corresponds to a price that the clients pay to purchase the at least one of the one or more products. However, Coyle discloses wherein the offering step includes conveying the first modification to the first data to the clients and wherein the first modification of the first data corresponds to a price that the clients pay to purchase the at least one of the one or more products (column 15, lines 13-40, the end users and resellers purchase telecommunications service *at the lower of the bid price* in the auction or a negotiated price from the telecommunications service provider). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Del Sesto's to incorporate the feature taught by Coyle

above, for the purpose of providing the clients of the first multiple provider entities are capable of purchasing the at least one of the one or more products.

Conclusion

8. Claims **1-3, 5, 6, and 8-21** are rejected.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-6796 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nga B. Nguyen/
Primary Examiner, Art Unit 3692

September 24, 2008